REMARKS

Claims 1-9, 11, and 16-34 are all the claims pending in the application. By this Amendment, Applicant cancels claim 33 without prejudice or disclaimer.

I. Preliminary Matter

As a preliminary matter, Applicant thanks the Examiner for indicating acceptance of the drawing figures filed on January 9, 2004.

II. Claim Rejections under 35 U.S.C. § 112

Claim 33 is rejected under 35 U.S.C. § 112, first paragraph. Applicant has cancelled claim 33 rendering this rejection moot.

III. Claim Rejections under 35 U.S.C. § 102

Claims 1, 2, 7-9, 11, 13-15, 18, 19, 24, 25, 30, and 31 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2005/0099990 to Uusikartano (hereinafter "Uusikartano"). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

As a preliminary matter, Applicant respectfully notes that claims 13-15 have been canceled without prejudice or disclaimer in the Amendment under 37 C.F.R. § 1.116 filed on October 26, 2006. Accordingly, this rejection of claims 13-15 is moot.

Of the remaining rejected claims, only claims 1, 9, and 11 are independent. Independent claims 1, 9, and 11 include, in some variation, a request for the setting-up or reconfiguration of a radio bearer for a packet session for a mobile station send by a core network entity to a radio access network entity, said request comprising **first information derived from quality of service information** contained **in a corresponding request received by said core network**

entity; **adding,** by said core network entity, to said request **second information, that is known at a level of said core network**.

In an exemplary, non-limiting embodiment, it is disclosed that in supporting real-time services, it is important to know the cell in which the mobile station (MS) is, and its capabilities (e.g., if it is EGPRS capable or not), the state of the cell (e.g., how loaded it is), and the MS capabilities (e.g. if the MS is EGPRS capable or not, and the MS's multislot class). Accordingly, in an exemplary, non-limiting embodiment of the present invention, a core network entity such as an SGSN includes in a request for setting up or reconfiguring a packet session first information derived from quality of service information received in the request from the MS and adds to the request second information, that is known in the SGSN, such as access capabilities of the MS described above. Accordingly, this request (having the first information and the added second information) is sent to a radio access network entity such as a base station subsystem (BSS), which uses the first and second information to determine whether a PDP context session may be established and performs the admission control procedure based on this information. It will be appreciated that the foregoing remarks relate to the invention in a general sense, the remarks are not necessarily limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claims mentioned above.

In response to Applicant's arguments, the Examiner appears to allege that since the core network in Uusikartano controls the set up and modification over UTRAN, inherently any message to the UTRAN will include the first and second information since the claims do not specify what is first and second information (*see* pages 3-5 of the Office Action). The Examiner, however, **did not identify information in Uusikartano that would disclose the first and second information as set forth in these independent claims**. The Examiner simply refers to

¶¶ 20-30 and Figs. 2 and 3 of Uusikartano. Applicant has carefully restudied these paragraphs and figures of Uusikartano and Applicant respectfully submits that Uusikartano does not disclose and it is not inherent in Uusikartano that the Radio Access Bearer (RAB) location procedure would include quality of service information received by the core network entity and the added information known at the core network entity level.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant's claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. MPEP § 2131.

Uusikartano only discloses that the RAB (radio access bearer) service is set up between the mobile station MS and the core network and it contains a service provided by the access layer to the non-access layer for forwarding user data. Different RABs are used according to the subscription, service, desired QoS or the like. The core network controls the set-up, modification and disassembly of RAB over the UTRAN. Set-up and modification of the RAB are functions that the core network initiates and the UTRAN implements (¶ 20). As is visible, Uusikartano is silent with respect to the **details as to how the core network sets up RAB over UTRAN**.

Uusikartano further discloses that the SGSN (core network entity) separates the original TFT value from message 2-5 and stores it temporarily in item 2-6. The RAB location procedure thereafter implements successful RAB modification by message 2-7. In a Modify PDP context accept message 2-8, the SGSN acknowledges the PDP context modification to the mobile station MS. In item 2-9, the SGSN eliminates the original TFT parameter from its memory. When the radio network controller RNC does not accept the new QoS profile in the RAB modification 3-7.

The SGSN then transmits a Modify PDP context reject message 3-8 to the mobile station MS to reject the RAB modification. The SGSN transmits an Update PDP context request message 3-9, which includes at least the original TFT value, to the GGSN. In item 3-10, the GGSN replaces the TFT parameter in its memory with the original TFT parameter. In item 3-11, the SGSN eliminates the original TFT parameter from its memory. In the network, this results in the same situation as before the modification procedure (¶¶ 28-30). In other words, with respect to the communication between UTRAN and SGSN, Uusikartano simply discloses RAB location procedure 2-7 and 3-7 in which QoS profile is used (Figs. 2 and 3).

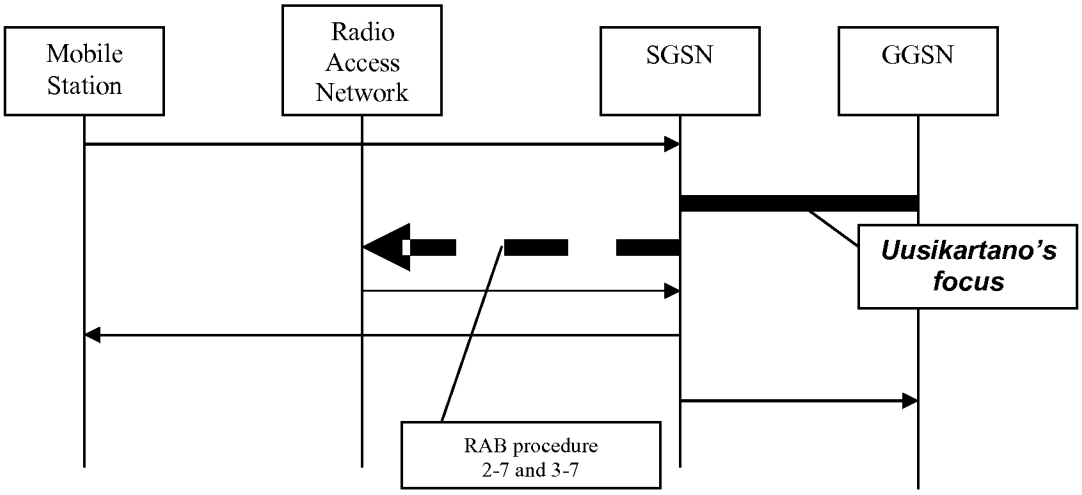
In short, with respect to the communication between UTRAN and SGSN, Uusikartano is no different from conventional techniques in that it simply discloses using QoS profile and fails to disclose a) adding any second information known at the SGSN level **and** b) where from the QoS profile is derived. Since Uusikartano lacks any details with respect to the RAB location procedure, the rejection is improper as it at the very least lacks "sufficient specificity" required under 102. "[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); MPEP § 2131.

Moreover, Uusikartano does not inherently disclose the first information derived from the received quality of service information and the second information known at the level of the core network entity. Under the doctrine of "inherency," if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference" *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherent

anticipation requires that the missing descriptive material is '**necessarily present**,' **not merely probably or possibly present**, in the prior art." (emphasis added) *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002); see also MPEP §2112.

In the present case, it is possible that RAB message 2-7 or 3-7 from the UTRAN to SGSN simply includes quality of service profile that may be received from the mobile station or already stored in the SGSN or received from elsewhere. In other words, in Uusikartano, the RAB messages 2-7 and 3-7 does **not** necessarily include QoS profile received from the MS **and** added information by the SGSN known at the SGSN. In short, the Examiner cannot establish inherency.

As previously explained, Uusikartano simply discloses that the RAB procedure exists. The details of the RAB procedure are not disclosed explicitly, implicitly, or inherently in Uusikartano. In fact, as explained in the Amendment under 37 C.F.R. § 1.111 filed on April 23, 2007, incorporated herein by reference, Uusikartano focuses on communication between SGSN and GGSN *i.e.*, saving old parameters so that in the core network old communication channel maybe restored in the event UTRAN (alleged RAN) will not permit a set up of new communication channel (*see* figure below).



In short, the only message in Uusikartano which is sent from the SGSN to the RAN for requesting reconfiguration of a connection are messages 2-7 in Fig. 2 and 3-7 in Fig. 3 which are described in paragraphs 28 and 30, respectively, and Uusikartano does not at any point suggest that these messages 2-7 and 3-7 **include both information derived from the QoS information contained in a request received by the SGSN as well as information known at the level of the SGSN and added to the message 2-7 and 3-7**.

In summary, the deficiencies of the Uusikartano reference fall to the Examiner's burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claims 1, 9, and 11 are patentable. Claims 2, 7, 8, 18, 19, 24, 25, 30, and 31 are patentable at least by virtue of their dependency on claim 1, 9, or 11.

In addition, the Examiner has failed to address arguments provided with respect to claims 2 and 8. Specifically, dependent claim 2 recites: "wherein said second information comprises information representative of radio access capabilities of said mobile station." The

Examiner contends that ¶ 22 of Uusikartano discloses these unique features of claim 2 (*see* page 3 of the Office Action). Applicant respectfully disagrees.

¶ 22 of Uusikartano recites:

> A mobile station associated with the GPRS system can commence the PDP context activation at any time by transmitting an Activate PDP context request message to the SGSN. After the SGSN has received the message, it transmits a Create PDP context request message to the GGSN, which sets up the PDP context and transmits it to the SGSN. The SGSN transmits the PDP connection to the mobile station MS in an Activate PDP context response message, and a virtual connection or link is set up between the mobile station MS and the GGSN. As a result, the SGSN forwards all the data packets from the mobile station MS to the GGSN, which in turn forwards all the data packets received from an external network and addressed to the mobile station MS to the SGSN. The PDP context is stored in the mobile station MS, the SGSN and the GGSN. When the mobile station MS moves to the area of a new SGSN, the new SGSN requests for the PDP context from the old SGSN, or if the transfer takes place in an active state, where the signalling connection is open between the UTRAN and the SGSN, the old SGSN immediately gives the PDP contexts to the new SGSN at the beginning of the transfer phase. The GPRS contract comprises one or more PDP addresses. The PDP context refers not only to the GPRS system but to any logical connection which is set up between the terminal and the network element responsible for the connection in order to transmit packet-switched data. Each PDP address is described by one or more PDP contexts in the mobile station MS, the SGSN and the GGSN. Each PDP context can be provided with a traffic flow template parameter (TFT parameter). Based on the TFT parameter, packets are filtered to different PDP contexts of the PDP address. The TFT parameter refers to filtering bases, i.e. to any parameter or group of parameters, on the basis of which a PDP context is selected for a data packet to be transmitted. A PDP address should have at most one PDP context with no associated TFT.

As is visible, **¶ 22 of Uusikartano is unrelated to the request message from the SGSN to the radio access network entity**. Clearly, ¶ 22 of Uusikartano does not disclose or even remotely suggest adding second information that includes information representative of radio access capabilities of the mobile station to such a request message. For at least these additional exemplary reasons, claim 2 is patentably distinguishable from Uusikartano.

Dependent claim 8 recites: "wherein said request for the setting-up or the reconfiguration of a corresponding radio bearer is sent in a CREATE BSS PFC message." Uusikartano does not disclose having CREATE BSS PFC message. Since Uusikartano only discloses configuring RAB over the UTRAN (¶ 22) and fails to disclose "CREATE BSS PFC message", the rejection is improper as it lacks "sufficient specificity" required under 102. Therefore, for at least this additional exemplary reason, Applicant respectfully submits that claim 8 is patentably distinguishable from Uusikartano.

IV. Claim Rejections under 35 U.S.C. § 103

Claims 3-6, 16, 17, 20-23, 26-29, 32, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Uusikartano in view of U.S. Publication No. 2004/0132441 to Livet (hereinafter "Livet"). Applicant respectfully traverses these grounds for a rejection at least in view of the following exemplary comments.

Claims 3-6, 16, 17, 20-23, 26-29, 32, and 34 depend on claim 1, 9, or 11. It was already demonstrated that Uusikartano does not disclose or suggest the unique features of claims 1, 9, and 11. Livet does not cure the deficient disclosure of Uusikartano (as explained in the Amendment under 37 C.F.R. § 1.111 filed on May 30, 2006, incorporated herein by reference). Accordingly, claims 3-6, 16, 17, 20-23, 26-29, 32, and 34 are patentable at least by virtue of their dependency on claim 1, 9, or 11 respectively.

In addition, dependent claim 34 recites: "wherein the request is a request for setting-up the radio bearer for a new packet session for the mobile station." The Examiner contends that ¶ 20 of Uusikartano discloses the unique features of claim 34. However, ¶ 20 of Uusikartano simply discloses setting up a RAB service, there is no disclosure of **a request and a packet session**. For at least these additional exemplary reasons, claim 34 is patentable over Uusikartano in view of Livet.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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